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Date: 7/11/06By: Patti Hespell
Patti HespellMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of John A. Schlack.

Conf. No.: 8297 : Group Art Unit: 2623
Appln. No.: 09/750,800 : Examiner: John Manning
Filing Date: 28 December 2000 : Attorney Docket No.: T721-20

Title: System and Method For Delivering Targeted Advertisements Using Multiple
Presentation Streams

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: 7/11/06

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Application No. 09/750,800

STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 62-71 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated January 11, 2006 ("Final Office Action") and the Examiner's Advisory Action dated June 12, 2006 ("Advisory Action"). Discussion of the prior art references and the pending claims may be found in Applicant's Amendment filed September 6, 2005 ("Amendment") and Applicant's Response After Final Rejection filed May 8, 2006 ("Response After Final"), both of which are incorporated herein by reference.

Hinderks Does Not Disclose All Elements of the Claims

Even though the Examiner has not established a case for anticipation, the Examiner has not withdrawn the rejection of claims 62-64, 68-69 and 71 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication 2001/0025377 to Hinderks ("Hinderks"). A summary of the Examiner's reasons for this rejection may be found at pages 2-5 of the Final Rejection and are also summarized at pages 2-4 of Applicant's Response After Final.

When making a rejection under 35 U.S.C. § 102(e), a single prior art reference must disclose, either explicitly or inherently, each and every element of the claimed invention. See MPEP 2131.

Applicant has submitted that Hinderks does not teach all of the elements of Applicant's claims (Response After Final, pages 3-4). In particular, Hinderks does not disclose "defining a plurality of market segments...generating a set of presentation streams corresponding to a programming channel having programming data, each of the presentation streams in the set corresponding to a different one of the plurality of market segments, each of the presentation streams in the set carrying the same programming data as the programming channel and at least one advertisement directed to the market segment to which the presentation stream corresponds, ... simultaneously delivering the set of presentation streams to a switching device," as recited in independent claim 62.

Application No. 09/750,800

The Examiner has argued that "the data streams of Hinderks referred to by the Applicant are multicast; therefore, the content is identical" (Advisory Action, page 4). In other words, the Examiner contends that, in Hinderks, the output 1008 of local server 1020 that is delivered to the router 1024 (switching device) is a set of data streams that have identical content. The Examiner, however, is incorrect; these data streams in Hinderks do not have identical content. Perhaps the Examiner has misunderstood the well-known operation of multicast transmission.

A multicast transmission does not, by definition, contain multiple streams, identical or otherwise. Hinderks provides a description of the operation of multicasting transmission: "only one copy of a signal is used until the last possible moment" (Par. [0018]; emphasis added). That is, in Hinderks, a multicast transmission that is delivered to the switching device consists only of a single stream having particular content. Furthermore, although it is certainly possible in Hinderks to deliver multiple multicast streams to the switching device, it is not at all implied in Hinderks that each of the multiple streams would have identical content, since that would completely defeat the advantage of multicast transmission, which is stated in Hinderks to be that "transmission costs and bandwidth used by the transmission would be minimized" (Par. [0018]). Thus, Hinderks does not disclose "generating a set of presentation streams corresponding to a programming channel having programming data, each of the presentation streams in the set carrying the same programming data as the programming channel ... simultaneously delivering the set of presentation streams to a switching device."

Furthermore, despite the fact that Hinderks does not disclose "defining a plurality of market segments", and does not even disclose the general concept of market segmentation, the Examiner continues to argue that the local commercials in Hinderks correspond to market segments (Final Office Action, page 2). As explained at page 4 of Applicant's Response After Final, Applicant strenuously disagrees with this contention, since the mere existence of local commercials does not imply defining market segments.

In light of the fact that Hinderks does not disclose all of the features of independent claim 62, the Examiner has not met the burden of establishing a case for anticipation. Accordingly, for the reasons detailed herein as well as in Applicant's Amendment and Response After Final, independent claim 62 and all claims dependent thereon, are allowable over Hinderks.

Application No. 09/750,800

No Support for Official Notice

The Examiner has refused to provide relevant references, as required by the MPEP, in support of the Official Notice taken with respect to three separate allegations of common-knowledge (Final Office Action, pages 5-6). Applicant has adequately traversed this Official Notice (Response After Final, pages 5-6). Applicant strenuously disagrees with the Examiner's contention at page 4 of the Advisory Action that Applicant has not adequately traversed the Examiner's taking of Official Notice.

The burden is on the Examiner to produce a reference substantiating the Official Notice: "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known....If such notice is taken, the basis for such reasoning must be set forth explicitly" (MPEP 2144.03). Thus, the burden is not on Applicant to prove that the Official Notice is incorrect. Rather, the Examiner is required to produce relevant references that would support the Official Notice. Applicant has satisfied his burden of 2144.03 by indicating the errors in the Examiner's Official Notice: "There are 'facts beyond the record' which are 'capable of such instant and unquestionable demonstration as to defy dispute' as being 'well-known' in the art" (Response After Final, pages 5-6). Applicant cannot prove the absence of common knowledge and simply guess at the Examiner's interpretation of what is common knowledge, nor is Applicant required to do so.

Applicant respectfully submits that the Examiner's rejections have been previously overcome, and that the application, including claims 62-71, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.